

REMARKS

This Response is submitted in response to the Office Action mailed on November 19, 2003. The Office Action rejects Claims 1-27 based on a number of references. Applicants respectfully submit for the reasons set forth below that the rejection is improper and should be withdrawn so as to avoid an unnecessary appeal to the Patent Office Board of Appeals for what Applicants respectfully submit is a clear misapplication of the law and facts.

The issue with respect to this matter appears to be straightforward. The principal reference, *Brescia*, teaches away from one of the claim limitations of Applicants' patent application. However, the Examiner relies on a second reference, *Clausen*, to remedy the deficiency of *Brescia*. The question is whether or not this is a proper obviousness analysis. Applicants respectfully submit it is not.

Applicants' claimed invention requires, in part, a moisture content of at least 25 percent by weight. *Brescia* relates to a moisture reduced food product having a moisture content of less than 20 percent by weight. See *Brescia*, column 1, lines 42-46. Although the secondary reference teaches a moisture content of above 25 percent, the question is is it proper to combine the secondary reference with *Brescia*. Applicants respectfully submit the law is clear, it is not.

As the Court of Appeals for the Federal Circuit has enunciated time and time again, hindsight must be avoided in crafting an obviousness analysis. See *In re Dembicza*k, 175 F.3d 994 (Fed. Cir. 1999). The test is not whether or not the prior art can be modified to achieve the claimed invention. The test is whether or not the art itself suggested desirability and modification. *In re Laskowski*, 871 F.2d 115 (Fed. Cir. 1989). One way to determine whether or not a hindsight analysis is being applied is if the art teaches away from the claimed concept. In this regard, "a prior art reference is relevant for all it teaches to those of ordinary skill in the art." *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992). "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the Applicant." *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353 (Fed. Cir. 1999). Indeed, if a first prior art reference "did in fact teach away from [a second reference], then that finding alone can defeat [an] obviousness claim based on a combination of the two references." *Winner International Royalty Corporation v. Wang*, 202 F.3d 1340 (Fed. Cir. 2000).

Applying the above law to the facts, clearly the obviousness rejection is not proper. The principal reference, *Brescia*, teaches away from Applicants' claimed invention of at least 25 percent by weight moisture. In this regard, *Brescia* discloses 20 percent or less moisture by weight. This fact is not disputed nor could it be disputed. In fact, *Brescia* wants a reduced moisture product. Therefore, the fact that one of the secondary references or even a plethora of secondary references disclose a moisture content of above 25 percent, is inapposite.

Brescia teaches to reduce moisture therefore *Brescia* teaches away from the claimed element in question. No number of references can change the disclosure of *Brescia*. The only motivation for modifying *Brescia* based on the prior art is a hindsight analysis that disregards the disclosure of *Brescia*. This is not proper and therefore the obviousness rejection should be withdrawn.

Accordingly, Applicants respectfully request reconsideration of their patent application and earnestly solicit an early allowance of same.

Respectfully submitted,

BELL, BOYD & LLOYD LLC

BY



Robert M. Barrett
Reg. No. 30,142
P.O. Box 1135
Chicago, Illinois 60690-1135
Phone: (312) 807-4204

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